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10/803,309	03/18/2004	Andrea C. Hughes-Baird	112300-2102	5766
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K&L Gates LLP P.O. Box 1135 CHICAGO, IL 60690				
EXAMINER				
SAGER, MARK ALAN				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
03/12/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

### Office Action Summary

**Application No.**

10/803,309

**Applicant(s)**

HUGHS-BAIRD, ANDREA C.

**Examiner**

M. Sager

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-114 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 4/8/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Information Disclosure Statement***

1. The information disclosure statement filed 5/8/04 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because other references lack page indication and/or date. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 48-114 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The determination whether claimed invention is statutory is a threshold determination based upon law. On October 26, 2005, the USPTO published Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility. See: [http://www.uspto.gov/web/offices/pac/dapp/opla/pcognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/pcognotice/guidelines101_20051026.pdf)

This guideline details a procedure for determining patent eligible subject matter. As to the claims, the first step in this process is whether the claimed invention falls within one of enumerated categories. In this application, the claims are drawn to a process – via claiming a “method” and thus meet this step for being one of the categories. However, a ‘process’ has been given specialized, limited meaning by the courts. Based on Supreme Court precedent, the

process must either (1) be tied to another statutory class or (2) transform the underlying subject matter to a different state or thing. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972). Regarding process determination, the claimed process of the above claims of this application is not tied to another statutory class. The language ‘of operating a gaming device’ is a nominal reference in this case that does not claim/require specific structure or is an intended/environment of use. The next step is whether the process transforms the underlying subject matter to a different state or thing. In the immediate application, the “method” having the steps of “displaying ... enabling... picking... forming... repeating... providing...” does not transform the underlying subject matter to a different state or thing since the steps include the abstract idea of what may be performed and also do not require a transformation to a different state or thing. The steps do not include another statutory class and do not transform the underlying subject matter to a different state or thing for reasons stated above in that the claims include the abstract of what steps may be performed and the steps do not transform the underlying subject matter to another state or thing. In essence, the claimed invention includes either written/coded instruction [not on computer readable media but may be on paper] or an abstract idea [the thought of performing] of acts that could be performed but not embodied in a form that requires an act to be performed by structure. The steps do not transform the underlying subject matter to a different state or thing. The step ‘providing an award’ is a nominal action that fails to transform the underlying subject matter of process to a different state or thing since the step does not impose meaningful limits on the process and thus is an insignificant extra-solution activity. Also, the ‘wherein’ steps regarding ‘through a data network... is an internet, fails to tie the process to another statutory category since the process refers to a signal being provided and a signal per se is not statutory. MPEP

2106. Also, see Memorandums dated May 15, 2008, entitled 'Clarification of Process under 35 USC 101' and Jan. 7, 2009 by J. Love, entitled 'Guidance for Examining Process Claims in View of *In re Bilski*' at [http://ptoweb/patents/3700/documents/101\\_process\\_%202008.pdf](http://ptoweb/patents/3700/documents/101_process_%202008.pdf) and [http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski\\_guidance\\_memo.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski_guidance_memo.pdf).

In view of the above analysis, applicant's invention of claims 48-114 is a process. Upon review of the claims as a whole, there is no transformation nor is the process tied to another statutory category. Accordingly, the claims are non-statutory under 35 U.S.C. 101. *In re Bilski* 545 F.3d 943, 88 USPQ2d 1385 (Fed Cir. 2008). Claims 1-47 are statutory as being a machine.

#### ***Claim Interpretation***

4. Per MPEP 2111.04, claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are (A) "adapted to" or "adapted for" clauses, (B) "wherein" clauses, and (C) "whereby" clauses. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Id.* Per MPEP 2114.01, while features of an apparatus may be recited either

structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, the 'wherein' clauses merely state the environment of use, or intended result or the clause fails to state a condition material to its patentability as provided in further evidence below.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-114 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. **6726565**. Although the conflicting claims are not identical, they are not patentably distinct from each other because Hughs-Baird '565 claims a gaming device having an input device, display and a processor performing function of player selection of a starting value and modifiers of claims herein. Also, providing remote play through a network such as internet is common place in gaming for increasing accessibility that increases revenues from increased game play while having reduced overhead such as taught by Yoseloff. Hence, it would have been obvious to an artisan at a time prior to the invention to apply providing the steps through a network such as internet as suggested by Yoseloff to improve process and gaming device of Hughs-Baird for the predictable result of increasing accessibility that increases revenues from increased game play while having reduced overhead. A server linked to a network for connecting with remote computers has less overhead than banks of gaming machines installed/maintained in a fixed location gaming hall.

7. Claims 1-114 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-72 of U.S. Patent No. **6439995** and over claims 1-76 of U.S. Patent No. **6595854** and over claims 1-40 of U.S. Patent No. **7182689**. Although the conflicting claims are not identical, they are not patentably distinct from each other because Hughs-Baird ('995, '854, '689) claims a method and a gaming device having a display and a process performing function of player selection of a starting value and modifiers of claims herein. Also, providing remote play through a network such as internet is claimed by Hughs-Baird ('995, '854, and '689).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-55, 57-62, 64-67, 69-74, 76-81, 83-88, 90-94, 96-100, 102-107, 109-113 are rejected under 35 U.S.C. 102(e) as being anticipated by Glavich (6309300). Glavich discloses a gaming device and method (abstract, 1:66-2:29, figs 1-4) comprising a game, a display device (fig 1), a plurality of starting values based on player wager, a plurality of selections, a numerical modifier, a processor operating with a display device (fig 4), displaying and providing starting values, enabling player to associate starting value with picked selection based on wagered amount, forming an ending value, repeating steps based on number of picks, providing an award (abstract, 1:66-2:29, figs 1-4) where in so far as buses and communication lines is a data network within a gaming device, Glavich includes a data network (fig 4) whereby the picks/selections include a prize amount, a demerit, additional pick opportunities or a combination that by happenstance of selection performs claimed steps.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the



inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 55-56, 62-63, 67-68, 74-75, 81-82, 88-89, 94-95, 100-101, 107-108, 113-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich in view of Yoseloff (6311976) or Walker (6174235). Alternatively where data network refers to a network of computing devices, Glavich lacks permitting remote play by providing the steps through a data network such as the internet. However, providing remote play through a data network such as internet is common place in gaming for increasing accessibility that increases revenues from increased game play while having reduced overhead such as taught by Yoseloff and Walker. Hence, it would have been obvious to an artisan at a time prior to the invention to apply providing the steps through a data network such as internet as suggested by Yoseloff or Walker

to improve process and gaming device of Glavich for the predictable result of increasing accessibility that increases revenues from increased game play while having reduced overhead. A server or group of servers linked to a network for connecting with remote computers for game play has less overhead expense than banks of gaming machines installed/maintained in a fixed location gaming hall at least in part due to less labor cost as well as reduced facilities expense.

***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/  
Primary Examiner, Art Unit 3714